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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,249	12/04/2003	Ravi Hariprasad	106951-0005	7788
21125 7590 01/09/2008 NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			EXAMINER HARRELL, ROBERT B	
			ART UNIT 2142	PAPER NUMBER
			NOTIFICATION DATE 01/09/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

## Office Action Summary

**Application No.**

10/728,249

**Applicant(s)**

HARIPRASAD ET AL.

**Examiner**

Robert B. Harrell

**Art Unit**

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 04 December 2003 st seq.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)                           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application                 |
| Paper No(s)/Mail Date <u>20031204</u> .  | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

1. Claims 1-38 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The first page of this application requires to be updated to indicate that the pending United States Patent Application therein listed is now abandoned.
4. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks <sup>TM</sup>, and other legal symbols <sup>®</sup>, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

**A person shall be entitled to a patent unless -**

**(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;**

6. **Claims 1-38 are rejected under 35 U.S.C. 102 (e)** as being anticipated by Cotichini et al. (United States Patent Number: 6,300,863).

7. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

8. Cotichini taught a method (e.g., see Title) of controlling remote computing devices (A1, A2, A3, and A4 of figure 1) containing associated client components (i.e., Agents per the Summary Of The Invention in col. 2 (lines 30-45)), the method comprising a given client component (i.e., and Agent in col. 2 (lines 30-45))

a) contacting a status server (e.g., see figure 1 C host Monitoring System, that portion that stores status, (also see figure 2 (9x and/or 9y))) containing client component status information (e.g., see col. 26 (line 62-et seq.));

b) receiving client component status information from the status server (i.e., the host answers the calling laptop) relayed in response to the client component contacting the status server;

c) evaluating the received status information to determine a status of the given client component (i.e., since the host answered the calling laptop, the calling laptop assumes it is stolen) (e.g., see figure 12, col. 4 (lines 15-29), col. 5 (lines 19-22), and paragraph 9 below));

d) in response to determining a particular status (i.e., since the laptop noticed the call was answered, it assumes it is stolen and thus obtains commands), contacting a command server (that part of the Host (e.g., see figure 2) that sends commands to the client per col. 11 (lines 24-31)) configured to send executable commands to the client component (e.g., see col. 4 (lines 15-29), and col. 11 (lines 24-31)) in response to being contacted;

e) receiving a command from the command server instructing the client component to perform a desired task (e.g., see col. 4 (lines 15-29) and col. 17 (line 10)); and,

f) in response to receiving said command, performing the desired task (e.g., see col. 4 (lines 15-29) (i.e., any DOS command such as "del"), or traceroute).

9. Since the agent, running on the client laptop computer (for example), checks if the host has any data or commands for the client (e.g., see col. 11 (lines 24-31)), any command(s), such as traceroute of col. 4 (lines 15-29) would indicate a status to the client. Clearly if the agent in the client was ordered to execute a traceroute, this would indicate to the agent in the client laptop that the status of the client laptop computer was listed as stolen. Also, per col. 4 (lines 3-7), if the host does not answer the calling agent, then the calling client agent is aware of the fact it is not on a stolen list and thus the status is set to not stolen. Also note col. 26 (line 62-et seq.)).

10. Per claim 2, see (e.g., see col. 4 (lines 15-29)) and figure 17B.

11. Per claim 3 and claim 4, figure 1 shows the computer(s) was/were laptop(s) or handheld computer(s) that might be stolen per Title and Abstract.

12. Per claim 5, claim 6, claim 7, and claim 8, see figure 2 in that direct dialup was direct and independent communication with the client and/or via a common computer network such as the Internet that contained mirrored servers.

13. Per claim 9 and claim 10, see col. 4 (line 2).

14. Per claim 11, since the host sent commands and since col. 22 (lines 2-3) indicate there was software upgradeable ISA, it was anticipated that such upgradeable ISA commands was within the scope of Cotichini and that upgrading old with new effectively deleted the old.

15. Per claim 12, see col. 3 (line 63-et seq.).

16. Per claim 13, see col. 8 (line 46).

17. Per claim 14, overwriting old data with new data (i.e., upgrade as addressed above) is a form of deletion; and, "del" was within the scope of DOS commands and thus anticipated.

18. Per claim 15, claim 16, claim 17, claim 18, and claim 19, see figure 4A-1 and/or 4A-2 for COM port searching, ATZ Hayes commands and the like. As for disabling the speaker, it was anticipated, and desirable, that a thief not hear the series of tones, buzzes, and screeches normal to dialing out via a modem as such would put the thief on notice and who most likely would disable the telephone line.

19. Per claims 20-38, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

20. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:

a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103.

22. **Claims 1-38 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Cotichini et al. (United States Patent Number: 6,300,863).

23. Obviousness from a prior art reference would follow, ipso facto, if prior art reference anticipates. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1446, 221 USPQ 385, 390 (Fed. Cir. 1984), citing In re Kalm, 378 F.2d 959, 962, 154 USPQ i0, 12 (CCPA

1967), (anticipation stated as being the "epitome of obviousness"). Also, the question is not whether the combination was obvious to the applicant but whether the combination was obvious to a person with ordinary skill in the art (KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL. (United States Supreme Court (Decided April 30, 2007))).


24. Per deleting data and turning off the modem's speaker, it would have been obvious to those skilled in the art for the server to issue a delete command to the client such that the client to destroy (i.e., low level disk format) any sensitive data because such deletion would have protected valuable information of the true owner, say, for example, identity theft or list of passwords. As for the modem's speaker, it would have been obvious, and desirable, that a thief not hear the series of tones, buzzes, and screeches normal to dialing out via a modem as such would put the thief on notice who most likely would disable the telephone line thus preventing any incoming commands for the server to the laptop computer. Finally, since status and commands were sent from the host to the laptop computer, that portion of the host issuing the status would have been a software status server and that portion of the host issuing commands would have been a software command server. Nonetheless, having two tangible physical servers would have been obvious to those skilled in the art since most Web sites contained more than one server with more than one function (i.e., ftp server per col. 17 (lines 4-15)). Also, per deleting, such was encompassed and thus expected within the set of DOS commands as "del" in col. 17 (line 10).

**25. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).**

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (571) 273-8300.

28. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

  
ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2142